REMARKS

This paper is filed in response to the final official action dated October 19, 2006, and the advisory action dated February 5, 2007. This paper is timely-filed as it is accompanied by a petition for an extension of time to file in the first month and a check covering the requisite fee of $120.00.

Claims 1-24 are pending. Claims 1, 3-5, 8, 9, and 23 have been rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,170,669 to Okada[1] ("Okada") in view of U.S. Patent No. 5,649,999 to Wang ("Wang").

Claims 6 and 7 have been rejected under 35 U.S.C. §103(a) as obvious over Okada in view of either U.S. Patent No. 4,172,064 to Keeler[2] ("Keeler") or U.S. Patent No. 4,365,035 to Zabiak ("Zabiak"). Claims 1-5, 8-14, 17, 18, 23, and 24 have been rejected under 35 U.S.C. §103(a) as obvious over Okada in view of Wang and U.S. Patent No. 5,196,243 to Kawashima[3] ("Kawashima"). Claims 6, 7, 15, and 16 have been rejected under 35 U.S.C. §103(a) as obvious over Okada in view of Wang and Kawashima, and further in view of Keeler or Zabiak.

Claims 19-22 have been objected to, but are allowable in substance.

Claim 23 has been amended to recite "or a volatile acid." Support may be found, for example, in original claim 10. No new matter has been added.

Claims 19 and 21 have been amended to be in independent form. The Office is authorized to charge our deposit account no. 13-2855 in the amount of $400 for two additional independent claims in excess of three.

Applicants respectfully submit that the present amendments do not affect the allowability of claims 19-22. Accordingly, claims 19-22 are now in condition for allowance, and applicants respectfully request an indication of same.

With respect to the examiner's indication at page 2 of the advisory action that "water [is] critical or essential to the practice of the invention," the applicants

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[1] The action dated October 19, 2006, mistakenly references U.S. Patent No. 4,706,699 to Okada instead of U.S. Patent No. 4,170,669 to Okada (as does the response filed January 19, 2007).

[2] The action dated October 19, 2006, mistakenly references U.S. Patent No. 4,172,604 to Keeler instead of U.S. Patent No. 4,172,064 to Keeler (as does the response filed January 19, 2007).

[3] The action dated October 19, 2006, mistakenly references U.S. Patent No. 4,170,669 to Kawashima instead of U.S. Patent No. 5,196,243.

respectfully submit that the disclosure merely states that "[i]n an embodiment, an improved color changing correction fluid comprises water as the sole solvent ...." *See* application at page 2, lines 29-32. Notably, the application does not unequivocably state that water is necessary for practicing the claimed invention. Nonetheless, each of the claims now recites water and thus the examiner's previous comments are moot.

The bases for the claim rejections are addressed below in the order presented in the official action. Reconsideration of the application, as amended, is solicited in view of the following remarks.

CLAIM REJECTIONS – 35 U.S.C. §102

Claims 1, 3-5, 8-9, and 23 have been rejected as anticipated by Okada in view of Wang. The applicants respectfully traverse the rejections.

It is well-established that each and every limitation of a claimed invention must be present in a single prior art reference in order for anticipation to occur. *See*, for example, C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1349 (Fed. Cir. 1998). The standard for anticipation is one of strict identity.

Okada discloses a "method for leaving a marking on a fabric at a prescribed point in order to indicate a sewing position." *See* Okada at column 1, lines 10-13. The color marking composition comprises a water dispersion of an acid- or base-soluble inorganic pigment, a penetrant, a volatilization retardant, and an anti-settling agent. *See* Okada abstract. The volatilization retardant may be triethanolamine.

As the marking composition may further comprise an acid-base indicator, the action indicates that Okada anticipates claims 1, 3-5, 8-9, and 23. However, Okada explicitly teaches that:

> It should be noted that the above-illustrated amines dissolve in water so as to produce basic solutions. Therefore, if these amines are used as volatilization retardants it is *necessary* to employ as the pigment such pigments as do not dissolve in base, in other words, those which dissolve only in acid.

See Okada at column 4, lines 20-23 (emphasis added). Further, Okada also teaches that titanium dioxide is soluble in bases. *See* Okada at Table 1. Accordingly, Okada specifically teaches against combining titanium dioxide and a volatile base in a composition, as claimed. Furthermore, Okada teaches that titanium dioxide is soluble

in acids. Accordingly, Okada strongly teaches against combining titanium dioxide and a volatile acid, as claimed.

In view of the above, the applicants respectfully submit that the anticipation rejections of claims 1, 3-5, 8-9, and 23 over Okada have been overcome and should be withdrawn.

CLAIM REJECTIONS – 35 U.S.C. §103(a)

Claims 6 and 7 have been rejected as obvious over Okada in view of either Keeler or Zabiak. Claims 1-5, 8-14, 17, 18, 23, and 24 have been rejected as obvious over Okada in view of Wang and Kawashima. Claims 6, 7, 15, and 16 have been rejected as obvious over Okada in view of Wang and Kawashima, and further in view of Keeler or Zabiak. The applicants respectfully traverse the rejections.

The deficiencies of Okada are discussed above. Furthermore, Okada teaches against compositions comprising a combination of titanium dioxide and either (1) a volatile base or (2) a volatile acid, as explained above.

It is respectfully submitted that an obviousness rejection based upon a reference that specifically teaches against the claimed invention is manifestly improper, and should not be made.

Accordingly, the applicants respectfully submit that a *prima facie* case of obviousness has not been established, and that the various obviousness rejections of claims 1-18, 23, and 24 over Okada have been overcome and should be withdrawn.

CONCLUSION

It is submitted that the application is in condition for allowance. Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, she is respectfully invited to contact the undersigned attorney at the indicated telephone number.

Respectfully submitted,

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